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John J. Kelly, Jr.
John J. Kelly

Reg. No.: 29,182

Examiner: A. Chambliss
Art Unit: 2814

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : K. TATSUMI et al.
Serial No. : 09/254,118
Filed : May 19, 1999
For : METHOD OF PARTIALLY PLATING SUBSTRATE FOR ELECTRONIC DEVICES

Assistant Commissioner
for Patents
Washington, D.C. 20231

RESPONSE

SIR:

This communication is responsive to the Office Action mailed February 13, 2001. Reconsideration of the above-identified patent application is respectfully requested. A petition for an extension of time in which to respond to the Office Action accompanies this response.

Claims 1-9 are pending in the application.

§102/§103

Claims 1-4 and 6 were rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,687,901 to Hoshiba et al.

Claims 5, 7 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,687,901 to Hoshiba et al. in view of U.S. Patent No. 5,762,258 to Le Coz et al.

These rejections are respectfully traversed.

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**Hoshiba `901 Does Not
Anticipate Claim 1**

Claim 1 is the only independent claim pending in the application. Applicants maintain that Hoshiba `901 does not anticipate or identically disclose (§102) the subject matter of claim 1 of the present application.

The Office Action rejected independent claim 1 under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,687,901 to Hoshiba et al. for the same reasons as set forth in the previous Office Action (Office Action mailed June 6, 2000).

The Office Action mailed June 6, 2000 stated at page 2:

Hoshiba et al. discloses small balls B that are to be melted onto an inner lead of a film carrier, electrode pads of a chip, electrode pads of a printed circuit board or electrode pads of a flexible circuit board, so as to plate the electronic device with a different metal (see col. 9 lines 21-24).

The present invention, as defined in independent claim 1, is directed to "A method for partially plating a substrate for electronic devices". The method of the present invention comprises "arranging small balls at selected portions of a substrate". The method of the present invention further comprises "melting the small balls, thereby selectively plating the selected positions of the substrate". See pending amended independent claim 1.

Col. 9, lines 21-24 of Hoshiba `901 cited by the Office Action mailed June 6, 2000 reads:

According to the present invention, the small balls may be bonded to inner leads of a film carrier,

electrode pads of a semiconductor chip, electrode pads of a printed-circuit board, or electrode pads of a flexible circuit board.

Applicants maintain that this does not identically disclose or anticipate (§102) pending amended independent claim 1 defining the present invention which requires:

- (i) a method for partially plating a substrate;
- (ii) arranging small balls at selected portions of a substrate;
- (iii) melting the small balls, thereby selectively plating the selected portions of the substrate.

Applicants maintain that Hoshiba `901 does not anticipate under 35 U.S.C. §102, claim 1 of the present application. Hoshiba `901 only describes balls bonded to electrodes and is silent about the partial plating of the present invention as defined in independent claim 1. Therefore, there is no anticipation under 35 U.S.C. §102 of claim 1 by the Hoshiba `901 patent.

Since independent claim 1 of the present application is not anticipated under 35 U.S.C. §102 by Hoshiba `901, dependent claims 2-9 cannot be anticipated under 35 U.S.C. §102 by Hoshiba `901.

**Amended §103(c) Applies To
The Present Application**

35 U.S.C. §103(c) was amended effective November 29, 1999 to read:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the

invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Attached hereto as Exhibit A is the United States Code Service (USCS) publication of 35 U.S.C. §103 at pages 388-391 which includes explanatory notes. 35 U.S.C. §103(c) appears at page 389 and is highlighted in yellow.

Page 390 of Exhibit A starting at line 3, **1999**, and highlighted in yellow reads:

1999. Act Nov. 29, 1999 (applicable as provided by §4807(b) of such Act, which appears as a note to this section), in subsec. (c), substituted "one or more subsections (e), (f), and (g)" for "subsection (f) or (g)".

Thus, subsection (e) of §102 was added to 35 U.S.C. §103(c) by the Act of November 29, 1999.

The amendment to 35 U.S.C. §103(c) by the Act of November 29, 1999 is applicable to applications filed on or after November 29, 1999. Page 391 of Exhibit A starting at line 4, **Effective date of Nov. 29, 1999 amendment** and highlighted in yellow reads as follows:

Effective date of Nov. 29, 1999 amendment.
Act Nov. 29, 1999, P.L. 106-113, Div.
(b) §1000(a)(9), 113 Stat. 1536
(enacting into law §4807(b) of Subtitle H of Title IV of S. 1948 (113 Stat. 1501A-591), as introduced on Nov. 17, 1999), provides: "The amendment made by this section [amending subsec. (c) of this section] shall apply to any application for patent filed on or after the date of the enactment of this Act".

Thus, the inclusion of subsection (e) of §102 into §103 (c) is effective for applications filed on or after November 29, 1999.

**Amended §103(c) Applies
To The Present Application**

The present application is a Continued Prosecution Application (CPA) filed on December 1, 2000, i.e., after November 29, 1999. The November 29, 1999 amendment to 35 U.S.C. §103(c) therefore applies to this CPA.

Enclosed herewith as Exhibit B are pages 326 and 335 of Patent Trademark & Copyright Journal (PTCJ) Vol. 60, No. 1487 which reprints PTO Final Rule On Continuation and Provisional Applications 65 Fed. Reg. 50092.

Comment 16 appears in the third column of page 335, of Exhibit B, (65 Fed. Reg. 50101, highlighted in yellow, and reads as follows:

Comment 16: One comment asked whether a CPA under §1.53(d) filed on or after November 29, 1999, is an application for patent filed on or after November 29, 1999, such that the amendment to 35 U.S.C. §103(c) in §4807 of the American Inventors Protection Act of 1999 applies to the CPA.

Response: A CPA under §1.53(d) filed on or after November 29, 1999, is an application for patent filed on or after November 29, 1999 (regardless of the filing date of the prior application), such that the amendment to 35 U.S.C. 103(c) in §4807 of the American Inventors Protection Act of 1999 applies to the CPA.

It is therefore clear that the November 29, 1999 amendment if 35 U.S.C. §103(c) applies to CPA's filed on or after November 29, 1999 and therefore applies to the present application which is a CPA filed on December 1, 2000.

**Hoshiba `901 Can Only
Be §102(e) Prior Art**

Applicants maintain that Hoshiba `901 can only be §102(e) prior art. This is, Hoshiba `901 cannot be prior art under §102(a) or §102(b).

U.S. Patent No. 5,687,901 to Hoshiba et al. issued November 18, 1997 upon Application No. 557,943 filed November 14, 1995.

The present application claims convention priority from Japanese Patent Application No. 8-244268 filed in Japan on August 27, 1996. Therefore, the convention priority date of August 27, 1996 of the present application is before the November 18, 1997 issue date of Hoshiba `901. Therefore, Hoshiba `901 can only be prior art under 35 U.S.C. §102(e).

The Office Action mailed June 6, 2001 acknowledged the claim for foreign priority under 35 U.S.C. §119(a)-(d) and acknowledged that all of the CERTIFIED copies of the priority documents have been received.

In order to complete the claim to convention priority under 35 U.S.C. §119, an English language translation, under declaration, of priority Japanese Patent Application No. 8-244268 was attached to the Preliminary amendment filed with the CPA filing papers of the present application.

An alternative reason why Hoshiba `901 can only be prior art under 35 U.S.C. §102(e) is that the present application is a national phase under 35 U.S.C. §371 of PCT/JP97/02988 filed August 27, 1997 which is before the November 18, 1997 issue date of Hoshiba `901.

It is therefore submitted that Hoshiba `901 can only be prior art under 35 U.S.C. §102(e).

**Hoshiba `901 And The Present
Application Are Commonly Owned**

U.S. Patent No. 5,687,901 to Hoshiba et al. is assigned to Nippon Steel Corporation, Tokyo, Japan. The assignment is recorded in the United States Patent and Trademark Office at Reel/Frame 7801/0220.

The present application is assigned to Nippon Steel Corporation, Tokyo, Japan. The assignment is recorded in the United States Patent and Trademark Office at Reel/Frame 9907/0818.

Therefore, the Hoshiba `901 patent and the present application are commonly owned.

Claim 1 to 9 are Patentable

For the reasons previously discussed, Hoshiba `901 does not anticipate or identically disclose the subject matter of amended independent claim 1 of the present application. Therefore, independent claim 1 of the present application cannot be rejected under 35 U.S.C. §102(e) as being anticipated by Hoshiba `901.

Amended 35 U.S.C. §103(c) applies to the present application and the present application and Hoshiba `901 are commonly owned by Nippon Steel Corporation.

Therefore, amended 35 U.S.C. §103(c) prevents Hoshiba `901 from being used as a 35 U.S.C. §103(a).

It is submitted that the secondary reference, U.S. Patent No. 5,762,258 to Le Coz et al., does not disclose or suggest the subject matter of independent claim 1. Le Coz et

al. was only cited as a secondary reference against dependent claims 5, 7 and 8 for disclosing copper wiring formed on a ceramic substrate. See Office Action mailed June 6, 2000.



It is therefore submitted that independent claim 1, and claims 2-9 dependent thereon, are patentable.

CONCLUSION

It is submitted that in view of the foregoing remarks, the application is now in condition for allowance. It is therefore respectfully requested that the application be allowed and passed to issue.

Respectfully submitted,

KENYON & KENYON

Dated - 8/7/01

By John J. Kelly, Jr.
John J. Kelly, Jr.
Reg. No. 29,182

KENYON & KENYON
One Broadway
New York, NY 10004
(212) 425-7200

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